



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,813	03/22/2001	Allen R. DeCotiis	PNX1P003	5834

7590 10/20/2004
C. DOUGLAS MC DONALD, ESQ.
CARLTON FIELDS, ET AL.
P. O. BOX 3239
TAMPA, FL 33601-3239

EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/816,813

Applicant(s)

DECOTIIS ET AL.

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Status of Claims

1. Claims 1-18 have been examined.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-18 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The Applicant's claimed invention does not fall within the technological arts because no form of technology is disclosed or claimed, hence, the claimed invention does not promote the progress of science and the useful arts. Claim 1 is merely an abstract idea (e.g. a mathematical formula) as it is not tied to the computer arts. Claim 7 recites "computer code", while claim 13 recites "logic". However, the computer code is not stored on a computer readable medium and the "logic" is not embedded in a computer, for example, that is used to implement the claimed system. Further, the "usefulness" of claims 1, 7 and 13 is not apparent. Specifically, the outcome (i.e. a score or propensity) of the Applicant's claimed processing is merely a number without a practical application, and was

produced without transformation of the data by a machine, such as a computer. Hence the claimed invention does not produce useful, concrete and tangible result (*State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998)).

Claims 3, 5, 9, 11, 15 and 17 refer to a network or internet. However, these claims are directed to collecting "individual information" or "information" limitations that are not found in independent claims 1, 7 or 13 and therefore, are also lacking in utility.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2, 3, 5, 8, 9, 11, 14, 15 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 8 and 14 recite "the same" in line 2. Claims 3, 9 and 15 recite the limitation "the individual information" in 1. Claims 5, 11 and 17 recite "the information" in line 1. There is insufficient antecedent basis for the limitation ("the same", "the individual information" or "the information") in the claims.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 2, 4, 7, 8, 10, 13, 14, and 16 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Rothman et al., U.S. Patent No. 6,505,168.

As per claims 1, 2, 4, 7, 8, 10, 13, 14, and 16, Rothman et al. teach system for sorting individuals comprising:

- creating a model, calculating a score, that indicates a propensity, based on the model, and sorting and ranking individuals based on the score (figures 5 and 6; column/line 6/66-7/20)
- a model that sets forth a plurality of characteristics and a weight (i.e. equal) of each of the characteristics for calculating the score (column 4, lines 35-55; column 5, lines 38-64)

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3, 5, 6, 9, 11, 12, 15, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothman et al., U.S. Patent No. 6,505,168 in view of Schulze, Jr., U.S. Patent No. 6,233,564.

As per claims 3, 5, 6, 9, 11, 12, 15, 17 and 18, Rothman et al. teach a system for calculating a score and using the score to sort individuals (figure 6). However, Rothman et al. do not specifically recite using surveys to collect information on an intent to purchase a particular product. Schulze Jr. teaches a method for collecting information over a network such as the internet (abstract; figures 1 and 2; column 5, lines 32-59). Specifically, Schulze Jr. teaches asking customers about "anticipated major purchases" (column 2, lines 23-30; column 6, lines 46-53; column 8, lines 58-65; column 10, lines 47-52; column 15, lines 50-56). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Rothman et al. and Schulze Jr. in order to allow goods and services providers to more effectively and directly target consumers ('564, column 2, lines 23-30).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Smolen teaches offering promotions to users based on surveys
- Suzuki teaches offering coupons to users based on purchase histories

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

Art Unit: 3621

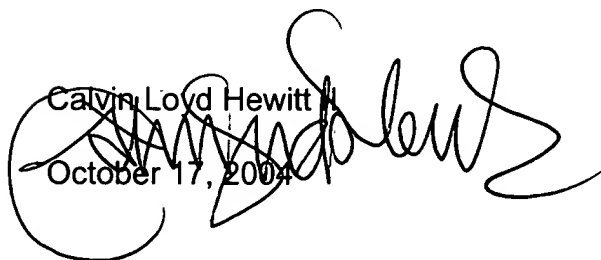
or:

(703) 746-5532 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application
should be directed to the Group receptionist whose telephone number is (703)
308-1113.

Calvin Loyd Hewitt
October 17, 2004

A handwritten signature in black ink, appearing to read "Calvin Hewitt", is written over the typed name and date. The signature is stylized with a large, looping initial "C".